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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,201	03/24/2000	David R. Larsen	4760	2945

758 7590 05/25/2007
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EXAMINER

WRIGHT, JAMES B

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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05/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/534,201

Applicant(s)

LARSEN, DAVID R.

Examiner

J. Bradley Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-15, 18-30, 33, 34, 37-46, 49, 50, 53 and 54 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 16, 17, 31, 32, 35, 36, 47, 48, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Prosecution Reopened

1. In view of the appeal brief filed on January 22, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

 5/21/07
James A. Kramer
Supervisory Patent Examiner
Group Art Unit 3693

Acknowledgements

2. The examiner for this application has changed. Please indicate Examiner J. Bradley Wright as the examiner of record in all future correspondences.

Declaration under 37 CFR 1.131

3. In light of the initial grounds presented by the previous Examiner underlying the finding of sufficiency, MPEP 715.02, and the subsequent arguments presented by Applicant, the Examiner has reconsidered the Declaration of David R. Larson filed on November 10, 2005 under 37 CFR 1.131. Upon further consideration, the Examiner finds the declaration to be ineffective to overcome the CheckFree's Recon-Plus for Windows (hereinafter Recon-Plus) reference for the following reasons.

4. MPEP 715.02 states that the 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). In the declaration, the Applicant asserts that the exhibits show the functionality for automatically identifying and reconciling one transaction to many.

The Examiner disagrees. As noted by the previous Examiner, the evidence provided with the declaration actually suggests that the steps for how the Applicant intended to accomplish the matching was still in development. For example, Exhibit A states "Can we do some 'auto-matching' to help the process along?" Clearly, as of Friday, Feb. 5, 1999 the details for how to handle the automatic matching were unknown. Additionally, Exhibits C and D indicate that as of March 12, 1999, the match was actually determined and the transactions reconciled upon the user "accepting" the

proposed match. Furthermore, there is no suggestion in the declaration or exhibits that the matching method involved was recursive.

MPEP 715.02 further states that where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. In re Stryker, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification. However, the Examiner has indicated that the invention of the rejected claims is anticipated by the Recon-Plus reference.

Applicant has argued that MPEP 715.02 also states that a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon, and that if the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. Thus, the sufficiency of the declaration depends on the reference being sworn behind. However, as noted above, the declaration does not contain facts showing a completion of the

invention commensurate with the extent of the invention as claimed is shown in the reference. The Examiner notes that the declaration actually shows much less of the claimed invention than the Recon-Plus reference. Applicant's evidence, namely Exhibits A, B, C, and D are not fully commensurate with the rejected claims.

MPEP 715.02 also states that even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. In re Spiller, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974)

However, the Applicant has not attempted to overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of Applicant's 37 CFR 1.131 evidence, prior to the effective date of the Recon-Plus reference.

5. Furthermore, as noted by the previous Examiner, for an Applicant's declaration to be sufficient evidence of conception and reduction to practice the declaration must present evidence so as to fully support the claims. However, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Recon-Plus reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C.Cir. 1897).

However, the evidence provided with the declaration suggests that the actual steps for how the Applicant intended to accomplish the matching had not yet been conceived, in particular, any functionality for automatically identifying and reconciling one transaction to many. For example, as noted above, Exhibit A states "Can we do some 'auto-matching' to help the process along?" and Exhibits C and D indicate that determination of a match was made or confirmed by a user. Also, as noted above, there is no evidence provided regarding the claimed recursive nature of the matching method.

Indeed, the previous Examiner explicitly noted that as a result of Applicant's failure to provide any support for the claimed invention, such specific steps must have been old and well known in the art. The Examiner further noted that the conclusion that the declaration was sufficient to overcome the Recon-Plus reference relied upon the fact that the specific steps claimed by Applicant were in fact old and well known in the

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art. Therefore, when Applicant challenged that these steps were not old and well known in the art, Applicant was making a convincing argument that the evidence provided with the declaration was not sufficient to properly show conception prior to the Recon-Plus reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-10, 13-15, 18-30, 33-34, 37-46, 49-50 and 53-54 rejected under 35 U.S.C. 102(a) as being anticipated by CheckFree's Recon-Plus for Windows (hereinafter Recon-Plus).

Examiner notes the use of the "The WayBack Machine" at www.archive.org for this Office Action. The Internet Archive is a comprehensive library of Internet sites and other cultural artifacts in digital form. The Wayback Machine is a free service allowing people to access and use archived versions of past web pages within the Internet Archive. Visitors to the Wayback Machine can type in a URL, select a date range, and then will be able to search and view the Internet Archive's enormous collection of web sites, dating back to 1996 and comprising Over 10 billion web pages. In this case the Examiner found an archived version of www.checkfree.com from Feb. 29, 2000 with a

description of Recon-Plus for Windows. The Examiner notes that CheckFree has sold Recon-Plus for Windows commercially since 1995.

Recon-Plus teaches an organization-wide reconciliation application which lets a user automatically balance any account - disbursement, depository, general ledger, Federal Reserve, bank accounts, foreign, wire transfer, etc - especially when single transaction must be matched with multiple transactions (Section D, lines 1-7). Recon-Plus further teaches data is imported either from an internal source or an external source (Section D; lines 61-64). Examiner notes that this represents obtaining the first transaction and obtaining the second list of transactions. In addition, this section represents obtaining transactions from a remote server or from a storage device (as required, in claims 4, 5, 24 and 25) and that each transaction comprises one selected from the group consisting of an investment transaction, a financial transaction and an accounting transaction (as required, in claims 2, 22 and 41 and claims 18, 37 and 53).

After data enters Recon-Plus, the system's dynamic matching engine goes to work. The system automatically matches as many items as possible based on matching criteria entered by the user. Matched data can be present in a variety of ways - for example, showing duplicate match scenarios and identifying potential matches (indicating a match). This matching intelligence simplifies the research process. The multiple pass engine in Recon-Plus automatically matches transactions to achieve the highest possible match rate. Items are first matched on a given set of criteria, then matching rules can be further expanded based upon less restrictive criteria. For example:

- One-to-one matching - Matching criteria are based on pairing single item with another single items
- Aggregate - Items are matched one-to-many or many-to-many.

Recon-Plus allows matching groups to be created even when the data is not perfect. For example:

- Tolerance - A variance can be specified by amount, date or percentage field. The system automatically generates any amount differences if the amount tolerance is selected.
- Proposed - The system or user can make suggested matches and other users can later approve the matches.

(Section D: lines 73-95)

Examiner notes that the "multiple pass engine" of Recon-Plus is the recursive submethod of Applicant's invention. Specifically, items are first matched based on a set of criteria and then the criteria is modified and the system attempts to match the items again (Section D; lines 79-82). As such the matching of Recon-Plus is clearly recursive or repeats (As specifically required in claims, 10, 13, 30 and 46).

Examiner further notes that the multiple pass engine (recursive submethod) can be used in order to reconcile transactions as one-to-one or aggregate (one-to-many or many-to-many) (section D; lines 84-86). This teaching represents determining whether the value of the first transaction corresponds to a sum of the values of a subset of transactions in the second list (required in claims 3, 19, 23, 38 and 42).

Examiner notes that the language of Recon-Plus, specifically, "Items are first matched on a given set of criteria, then matching rules can be further expanded based upon less restrictive criteria (Section D; lines 81-82)" indicates a layered approach. In

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other words, the multiple first determines that there isn't a one-to-one match and then expands the rules to check for a one-to-many relationship. This represents determining whether a first value corresponds to a subset of values (one-to-many) responsive to the first value not corresponding to a single value (one-to-one) as required in Claims 6, 26 and 43.

In addition Examiner notes that this type of layered matching can be applied to other criteria such as the date. Examiner points to Recon-Plus, Section D; lines 89-91, "A variance can be specified by amount, date or percentage field". This teaches that each transaction has a date. Recon-Plus further teaches that Match groups can be created using any field in the system and that Any data populated on the items can be viewed during the matching session (Section D; lines 95-96). Examiner notes that this represents the ability to match over a specific date or over a range of dates (obtaining a second list comprises obtaining a list of transactions having dates identical to the date of the first transaction or having dates within a specified time period of the date of the first transaction; required in claims 7-8, 27-28 and 44-45).

Examiner notes that claims 9 and 29 require modifying the specified time period and repeating the steps of obtaining the second list, determining whether the value of the first transaction corresponds to a combination of values of a subset of transaction in the second list, and, responsive to the value corresponding to the combination of values, indication a match between the first transaction and the subset of transaction. Once again this represents a layered approach to the reconciliation taught by Recon-

Plus (e.g. "items are first matched on a given set of criteria, then matching rules can be further expanded based upon less restrictive criteria (Section D; lines 81-82)").

Once again Examiner references Recon-Plus's teaching of aggregate criteria for matching and in particular the many-to-many criteria (Section D; line 86). Examiner notes that this represents reconciling a first combination of at least two transactions in a first list with a second combination of at least two transactions in a second list (required in claims 14, 20, 33, 39, 49 and 54).

Allowable Subject Matter

7. Claims 11-12, 16-17, 31-32, 35-36, 47-48, and 51-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Northington, et al. (US Patent Application Publication No. 2004/0205011) discloses an open-architecture system for real-time consolidation of information from multiple financial systems.
- Kovacs-Vajna (US Patent Application Publication No. 2001/0040989) discloses a method and device for identifying fingerprints.


- Nielsen (US Patent No. 6,591,011) discloses a picture processing method and apparatus.
- Kukura, et al. (US Patent No. 6,907,609) discloses an object request dispatch using matching of a segmented object key.
- Guzelsu (US Patent No. 6,381,587) discloses a method and system for standardizing and reconciling invoices from vendors.
- Josephson (US Patent No. 5,689,579) discloses a rule-based circuit, method and system for performing item level reconciliation.
- Zamora-McKelvy, et al. (US Patent No. 6,496,838) discloses a database reconciliation method involves, reconciling record in one database using matching record generated, by searching other database with progressively smaller set of identified query and search fields.
- Malcolm (US Patent No. 6,006,204) discloses uncleared transactions creation and reconciliation method in web based banking system.
- Dunn, et al. (US Patent No. 5,134,564) discloses a computer aided reconciliation method for bank records - when match value between two lists exceeds threshold value then corresponding records from lists paired and removed from further reconciliation processing.
- Green, et al. (US Patent Application Publication No. 2003/0191710) discloses an invoice purchase order system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bradley Wright whose telephone number is (571) 272-5872. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jbw

 5/21/07
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